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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,136	09/19/2001	Yutaka Tokura	35.C15798	8381

5514 7590 10/31/2006

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EXAMINER

HANG, VU B

ART UNIT PAPER NUMBER

2625

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/955,136	Applicant(s) TOKURA, YUTAKA	
	Examiner Vu B. Hang	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 0818/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-15, 17-19, 21-23 and 25-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-15, 17-19, 21-23 and 25-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This office action is responsive to the following communication: Amendment filed on 08/18/2006.
- Claims 1-10, 16 and 24 have been cancelled. Claims 11-15, 17-19, 21-23 and 25-32 are pending in the application.

Response to Arguments

1. Applicant's arguments filed 08/18/2006 have been fully considered but they are not persuasive. The applicant stated, on page 12, that the Kato system does not "provide the user with the ability to designate a particular ejection destination (sorter bin) in the color printer or in the monochromatic printer." The examiner disagrees for the following reasons. It is clear that Kato's system sends print data to either the color printer or the monochromatic printer, depending on the determining means determining whether the print data to be printed contains color data or not (see Fig.4 (S6, S9, S12) and Col.1, Line 57-65). It can also be seen that the user can designate a particular a particular ejection destination in either the color printer or in the monochromatic printer (see Col.5, Line 56-61).

2. The applicant also stated, on page 13, that the combination of the Kato reference and the Idehara reference would not be obvious for one with ordinary skill in the art and appears to be contradictory. The examiner disagrees for the following reasons. Kato's system divides the print job into two parts and sends each of the jobs to two separate printers (see Fig.4 (S6, S9, S12) and Col.1, Line 57-65) while Idehara's system uses one printer and divides the print job into a color portion and a monochromatic portion (see

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Fig.4C). Since the print jobs found in both references are divided into two parts prior to being printed, it is obvious for one skilled in the art to either have the print jobs executed within the same printer or using separate printers as in Kato's system. Kato prefers the use of multiple printers in favor of using optimum printing devices for quality prints and efficient printing, while Idehara favors the multifunction printer for compactness reasons. It is clear that both references are from the same field of endeavor, namely color and monochromatic image forming systems.

3. The applicant further stated, on page 14, that none of the references used teaches or suggests "adding control information to the image information or controller". The examiner disagrees for the following reasons. It can be seen that the control data (color flag indicator) for determining whether the print data is to be sent to the color printer or the monochromatic printer is added to the image data and the controller (see Fig.4 (S3, S5) and Col.5, Line 65 – Col.6, Line 9). Kato further discloses that the user can add control data to the image data and controller (see Col.5, Line 56-61).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 11, 13, 17-18, 19, 21 and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Kato (US Patent 5,978,557).

Regarding **Claims 11 and 19**, Kato discloses an information processing apparatus connected to a first printer and a second printer (see Fig.8, Col.1, Line 45-50 and Col.8, Line 60-61), comprising:

a discriminating unit adapted to discriminate to which of the first printer and second printer each page of information outputted (see Fig.4 (S8, S9, S12) and Col.1, Line 57-65);

an output unit adapted to output to the first printer, the print information which was determined to be outputted to the first printer, and to output to the second printer, the page in the print information which was determined to be outputted to the second printer (see Fig.4 (S8, S9, S12), Fig.8, and Col.1, Line 57-65); and

a controller, adapted to add control information for switching ejecting positions in regarding the pages in which a succession of page numbers was broken to the print information which is outputted to either the first or second printer by the output unit in a manner such that the pages are sorted and ejected on the basis of succeeding page numbers in the first or second printer (see Fig.7, Col.5, Line 4-30 and Col.6, Line 4-7).

Regarding **Claims 13 and 21**, Kato further discloses the controller adds control information in accordance with a sorting function a printer has (see Col.2, Line 1-10 and Col.5, Line 4-20).

Regarding **Claims 17 and 25**, Kato further discloses that the discriminating unit discriminates to which the first printer and the second printer each page of the print information should be outputted in accordance with whether information to be color

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printed exists in each page of the print information or not (see Fig.4 (S4, S8, S9, S12) and Col.1, Line 57-65).

Regarding **Claims 18 and 26**, Kato further discloses that the first printer is a monochromatic printer and the second printer is a color printer (see Fig.8 (2000,3000)).

Regarding **Claims 27 and 28**, Claims 27-28 cite identical features as Claim 11 except Claims 27-28 are computer readable medium claims. Thus, arguments similar to that presented above for Claim 11 are equally applicable to Claims 27-28 because without a computer readable medium to store a program that makes it possible for the apparatus to operate, the apparatus could not function.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US Patent 5,978,557) in view of Idehara (US Patent 6,912,057 B1).

Regarding **Claims 14 and 22**, Kato discloses the apparatus of Claim 11 but fails to disclose a sorter processing function for sorting and outputting each sheet by using a plurality of bins. Idehara, however, discloses a sorter processing function for sorting and outputting each sheet by using a plurality of bins (see Fig.1 (102), Fig.3A-3C, Col.4, Line 48-52).

Kato and Idehara are combinable because they are from the same field of endeavor, namely color and monochromatic image forming systems. At the time of the invention, it would have been obvious to include to the controller information for instructing the sorter processing function to sort and output each sheet by using a plurality of bins. The motivation would be to separate the documents for easy retrieval at the printing station.

Claims 15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US Patent 5,978,557) in view of Green (US Patent 5,513,839).

Regarding **Claims 15 and 23**, Kato discloses the apparatus of Claim 11 but fails to disclose a shift processing function. Green, however, discloses a shift processing function for deviating the ejecting position of each output sheet and putting the sheets onto the same tray (see Col.1, Line 53-67).

Kato and Idehara are combinable because they are from the same field of endeavor, namely color and monochromatic image forming systems. At the time of the invention, it would have been obvious to include to the controller shift processing instructions for deviating the ejecting position of each output sheet and putting the sheets onto the same tray. The motivation would be to partially separate the printed documents for easy retrieval at the printing station.

Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US Patent 5,978,557) in view of Idehara (US Patent 6,912,057 B1).

Regarding **Claims 29 and 31**, Kato discloses an information processing apparatus capable of communicating with a plurality of print control apparatuses including a color print control apparatus and a monochromatic print control apparatus (see Fig.1 (1,7),

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Fig.2, Fig.8 and Col.3, Line 25-31), the information processing apparatus comprising: a discriminating unit adapted to discriminate whether print data to be output to any of the plurality of print control apparatuses is color data or monochromatic data (see Fig.4 (S8, S9, S12) and Col.1, Line 57-65); a determination unit adapted to determine whether the print data to be output either to the color print control apparatus or the monochromatic print control apparatus based on the discrimination made by the discrimination unit (see Fig.4 (S8, S9, S12), Fig.8, and Col.1, Line 57-65); and designating an ejecting destination (see Fig.4 (S8, S9, S12)). Kato fails to disclose determining whether a page is serial or not. Idehera, however, discloses a sorting function that determines whether a page is serial or not (see Fig.1 (102), Fig.3A-3C and Col.4, Line 48-52).

Kato and Idehera are combinable because they are from the same field of endeavor, namely print document-handling systems. At the time of the invention, it would have been obvious for one skilled in the art to include to Kato's information processing apparatus a means for determining whether a page is serial or not. The motivation would to determine whether each of the pages belong to the same document in both the color print control apparatus and the monochromatic print control apparatus. This would benefit the reorganizing process when the related printed document sheets are regrouped together for retrieval.

Regarding **Claims 30 and 32**, Kato and Idehera disclose the apparatus of Claim 30 but fail to expressly disclose a holding unit adapted to hold information on the first or second ejection destination. Kato, however, discloses a print network system including a print server (see Fig.1 (1,7), Fig.2 (20) and Col.3, Line 29-31). At the time of the invention, it would have been obvious to use the print server as a holding unit for holding

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information on the first or second ejection destination. The motivation would be to automatically eject the document pages to either the first or second printer depending on the color information contained in the image data.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571) 272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vu Hang
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